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In re Application of Checrallah Kachouh
Appl. No.: 10/727,562
Filed: December 05, 2003
For: MOTOR VEHICLE DOOR LOCK

: **DECISION ON PETITION**
: **REQUESTING**
: **WITHDRAWAL OF**
: **PREMATURE FINALITY**
: **UNDER 37 CFR 1.181**

This is a decision on applicant's petition filed May 25, 2006 requesting withdrawal of premature finality of the office action mailed on February 15, 2006.

The petition is **GRANTED**.

After reviewing the above file, the file history shows that a non-final office action was mailed on September 8, 2005. In this office action, claims 10, 21, and 22 were rejected under 35 USC 112, second paragraph, claims 1-5, 18, 19, 21 and 22 were rejected under 35 USC 102(b) as being anticipated by US Pat. No. 6,390,517 to Ehret, claims 6-9, 11-17, and 20 were objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and claim 10 was indicated as being allowable if rewritten to overcome the rejections under 35 USC 112, second paragraph. Applicant then filed an amendment on December 6, 2005. This amendment amended independent claims 1, 21, and 22, and dependent claims 19 and 20. The remaining claims were left unchanged. In response to the amendment filed on December 6, 2005, the examiner then issued a final rejection that was mailed on February 15, 2006. In this final office action, claims 1-20 were rejected under 35 USC 112, second paragraph, claims 1-5, 10-12, and 20-22 were rejected under 35 USC 102(b) as being anticipated by US Pat. Publication No. 2001/0010427, claim 18 was rejected under 35 USC 103(a) as being obvious in view of the '131 patent, and claims 6-9, 13-17, and 19 were indicated as being allowable if rewritten to overcome the rejections under 35 USC 112, second paragraph. The applicant then filed an after final amendment on May 15, 2006. This amendment attempted to amend independent claims 1 and 21, dependent claim 20, and cancel claim 22. In response to this after final amendment, the examiner issued an advisory action indicating that the new limitations presented in the after final amendment changed the scope of the claims in a manner that would raise new issues and would require further consideration and search. In response to the advisory action, on May 25, 2006 applicant filed the petition requesting withdrawal of premature finality of the office action mailed on February 15, 2006.

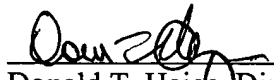
The petitioner argues that the finality of the February 15, 2006 office action was not proper because the examiner rejected claims 11 and 12 with a new grounds of rejection when claims 11 and 12 were previously indicated as being objected to but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The petitioner argues that since claims 11 and 12 were not amended, and they were rejected with a new ground of rejection, the Examiner should not have made the action final. The petitioner cited 37 CFR 706.07(a) which states that: "a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art."

In response to petitioner's arguments, it is agreed that the MPEP does in fact provide the guidance pointed out above by petitioner. However, due to the fact that independent claim 1 was amended in such a manner that the scope of the claim was changed, the new rejection was necessitated by the applicant's amendment. Thus, by amending the scope of independent claim 1, the scope of all claims being dependent upon independent claim 1 is also changed. Even though there were no physical changes specifically to claim 11 or 12, claims 11 and 12 were in fact amended because claim 11 includes all of the limitations of claim 1 and claim 12. In the same manner, claim 12 also includes all of the limitations of claim 1 and claim 12. Therefore, the examiner acted within the guidelines set forth in the MPEP when he made the action mailed on February 15, 2006 final because the applicant's amendment changed the scope of the claims in such a manner that allowed the examiner to reject the claims in view of a new prior art reference. However, during the review of the application in response to the petition, it was discovered that the examiner indicated that claims 8 and 9 would be allowed if rewritten to overcome the 35 USC 112, second paragraph rejections, but rejected claims 10-12. This is not correct, because claims 10-12 depend from claims 8 and 9. Therefore, if claims 8 and 9 would be allowable if rewritten, claims 10-12 would also be allowable due to their dependency on claims 8 and 9. Thus, the rejecting of claims 10-12 by the examiner was improper.

In conclusion, since applicant's amendment necessitated the new grounds of rejection set forth by the Examiner, the final rejection would have been proper. However, since the examiner erroneously rejected claims 10-12, the final rejection was improper. Thus, petitioner's petition is hereby **GRANTED**.

The application will be forwarded to the Supervisory Legal Instruments Examiner for removal of the final rejection status and entry of the amendment received May 15, 2006. The application will then be forwarded to the examiner for consideration of applicant's response.

Any questions regarding this decision should be directed to Brian Glessner at 571-272-6843.


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